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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,500	01/07/2002	Nigel M. Goble	2558-57	4541

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EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,500

Applicant(s)

GOBLE, NIGEL M.

Examiner

Peter J Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-42 and 44-47 is/are allowed.
- 6) ☒ Claim(s) 31-38 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-30 are withdrawn.

Claims 39-42 and 44-47 are allowed (39 and 44 independent).

Claims 31-38 and 43 are rejected below using newly found art (Edwards et al.).

The instant action is **non-final** because new art is presented to reject claim 31, which is still in its original format.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards et al. ('257).

Independent claims 31 and 34

Edwards et al. (Edwards) discloses a method of treating a tumor in a colon (col. 1:52-60; see figure 1) using an electrosurgical system comprising:
an electrosurgical generator (inherent) adapted to generate a radio frequency oscillating voltage output across first and second output terminals;

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an electrosurgical instrument (110) having an active tissue treatment electrode (113) connected to the first generator output terminal;

fluid delivery means (117) for delivering electrically-conductive fluid to the tumor to be treated; and

a return electrode (113) connected to the second generator output terminal,

the method comprising the steps of:

enclosing, in a substantially fluid-tight manner (col. 2:25-35), a space in the colon within which the tumor to be treated is located, and within which at least the active electrode is located (see figure 1);

operating the fluid delivery means at least partly to fill the space with electrically-conductive fluid (col. 4:28-34);

operating the generator to apply a radio frequency voltage between the active and return electrodes, and completing at least a part of a conduction path between the active and return electrodes using the electrically-conductive fluid;

and manipulating the active electrode (col. 4:54-61) in the vicinity of the tumor to be treated.

Claim 34 additional limitation

Edwards also discloses an electrosurgical instrument comprising a shaft (111), and the active and return electrodes (113) are located on a distal end of the shaft (see figure 1),

the method further comprising the steps of positioning the proximal end of the shaft to extend out of the space (see figure 1),

and manipulating (131,132) the active electrode by moving the proximal end of the shaft.

Dependent claims

Re: claim 32: Edwards discloses tumor vaporization in col. 8:25-31. The Examiner contends that vaporization is equivalent to ablation (at least in the patent literature), and that dehydration/denaturation (col. 8:29-31) also could be associated with vaporization.

Re: claim 33, Edwards discloses positioning the return electrode (113) within a space in the colon (see figure 1).

Re: claim 35: Edwards discloses waste matter removal ("aspirating", col. 4:28-34).

Re: claim 36: Edwards discloses use of gas in patented claim 27.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards in view of Mueller et al. or Sharkey et al. or Baker et al. or Arenberg et al.

Each of the supporting patents above includes the phrase, "ablation or vaporization". The phrase is found in each patent respectively, col. 10:50-51; col. 1:18; col. 22:53-57; and col. 8:303-5. The Examiner contends that these four patents sufficiently show that ablation and vaporization are equivalent or at the very least obvious in light of each other (as seen in the patent literature). As a result, the Edwards reference in view of the other four supporting patents makes obvious a colonic tumor treatment in which the surrounding colonic space is isolated and the tumor is vaporized.

Allowable Subject Matter

Claims 39-42 and 44-47 are allowed. Reasons for allowance are articulated in the Office Action dated January 6, 2004.

Claims 37-38 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Edwards does not disclose a flexible enclosing member such as that in the Applicant's figure 15 element 261.

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Edwards also does not disclose *reducing* pressure in the colonic space. Indeed, Edwards discloses *increasing* pressure in the colonic space (col. 9:55-62).



The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Edwards et al. ('673).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Vrettakos whose telephone number is 703 605 0215. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on 703 308 0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
May 11, 2004



MICHAEL PEFFLEY
PRIMARY EXAMINER